



Gabara 91-2-36

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): T.J. Gabara et al.
Case: 91-2-36
Serial No.: 10/719,193
Filing Date: November 21, 2003
Group: 2816
Examiner: Jermele M. Hollington

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature: *Lisa L. Ulpas*

Date: April 10, 2006

Title: Integrated Circuit with Controllable Test Access
to Internal Analog Signal Pads of an Area Array

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection, dated January 9, 2006, in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is submitted concurrently herewith.

REMARKS

The present application was filed on November 21, 2003 with claims 1-20. Claims 1-20 are currently pending in the application. Claims 1, 19 and 20 are the independent claims.

In the final Office Action, claims 1, 3, 4, 6-8, 10-13, 18 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,969,538 (hereinafter "Whetsel") in view of the admitted prior art of FIG. 2. In addition, claims 17 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Whetsel in view of the admitted prior art of FIG. 2 in further view of U.S. Patent No. 6,681,352 (hereinafter "Fredrickson").

The Examiner indicates that claims 2, 5, 9 and 14-16 would be allowable if rewritten in independent form.

The grounds for the §103(a) rejections in the final Office Action are identical to those presented in the prior, non-final Office Action, dated July 25, 2005. Applicants previously traversed these grounds in their Amendment and Response to Office Action, dated October 20, 2005 (hereinafter "Prior Response"). Applicants continue to respectfully traverse the rejections of claims 1, 3, 4, 6-8, 10-13 and 17-20 and continue to maintain their arguments already of record.

Applicants initially note that for a valid §103(a) rejection, the reference or reference combination must teach or suggest all the claim limitations. Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §2143. In addition, an obviousness rejection based on a combination of references must show "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Id.

Claim 1 sets forth:

An apparatus comprising:

an integrated circuit die comprising an internal signal pad arranged at a location away from a periphery of the die, a peripheral signal pad arranged proximate the periphery of the die, and a switch coupled between the internal signal pad and the peripheral signal pad;

the switch being configurable in at least a first state in which the internal signal pad is not operatively connected to the peripheral signal pad, and a second state in

which the internal signal pad is operatively connected to the peripheral signal pad;
the switch being configurable in one of the first and second states responsive
to a control signal having one of first and second signal characteristics, respectively;
wherein the switch is configured in the first state during normal operation of
the integrated circuit die; and
wherein the switch is configured in the second state to permit test access to
the internal signal pad via the peripheral signal pad.

In formulating the §103(a) rejection of independent claim 1, the Examiner argues that the Whetsel-FIG. 2 reference combination teaches or suggests “a switch coupled between the internal signal pad and the peripheral signal pad” (final Office Action, p. 2). Applicants respectfully disagree and refer the Examiner to the rebuttal made in the Prior Response at page 4.

In addition, Applicants respectfully assert that Whetsel and the FIG. 2 prior art are devoid of any suggestion or motivation that would cause one skilled in the art to combine the references in the way suggested by the Examiner. To the contrary, both Whetsel and FIG. 2 teach away from the combination proposed by the Examiner. Applicants refer the Examiner to the rebuttal made in the Prior Response at pages 4 and 5.

It is noted that, in the final Office Action on pages 7 and 8, the Examiner responds to the prior rebuttal concerning teaching away. However, the Examiner’s comments appear to address generally applicable aspects of motivation to combine references rather than the specifics of the Applicant’s assertions concerning teaching away. Applicants, therefore, respectfully maintain their assertion that the proposed reference combination teaches away from the limitations of claim 1.

For the cited reasons, Applicants respectfully submit that claim 1 would not have been obvious at the time the invention was made in view of the Whetsel-FIG. 2 combination. Independent claim 19 contains analogous limitations to claim 1. Therefore, Applicants also submit that this independent claim should be allowed for reasons similar to those cited above for claim 1.

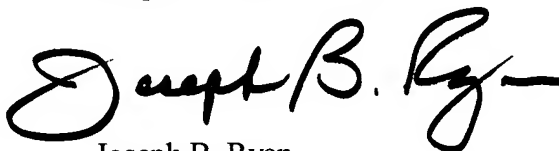
Dependent claims 3, 4, 6-8, 10-13 and 18 are believed to be in condition for allowance for at least the same reasons as their respective independent claims.

With respect to the §103(a) rejection of claims 17 and 20 over Whetsel in view of the admitted prior art of FIG. 2 in further view of Fredrickson, Applicants note that Fredrickson does

not correct the fundamental deficiencies of Whetsel and the FIG. 2 prior art, as described above. Therefore, claims 17 and 20 would also not have been obvious at the time the invention was made.

In view of the above, Applicants believe that claims 1-20 are in condition for allowance, and respectfully request the withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan", with a stylized flourish at the end.

Date: April 10, 2006

Joseph B. Ryan
Attorney for Applicant(s)
Reg. No. 37,922
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7517